

## CLAIM AMENDMENTS

Please cancel claims 1-10 and 13-41 without prejudice or disclaimer.

1-10. (Canceled)

11. (Currently Amended) The isolated nucleic acid molecule of claim [[10]]11, wherein said tocopherol cyclase is encoded by a nucleotide sequence of SEQ ID NO: 38.

12. (Currently Amended) The An isolated nucleic acid molecule encoding a tocopherol cyclase of claim 10, wherein the isolated nucleic acid molecule is operably linked to a heterologous promoter functional in a plant and wherein said nucleic acid molecule encodes an amino acid sequence of SEQ ID NO: 39.

13-41. (Canceled)

42. (Currently Amended) The isolated nucleic acid molecule of claim 102, wherein said prokaryotic cell source nucleic acid molecule is a from *Synechocystis* sp.

43. (Currently amended) An isolated nucleic acid molecule comprising a nucleic acid sequence which is at least 95% identical over its entire length to the nucleic acid sequence of SEQ ID NO: 38, wherein the isolated nucleic acid molecule is operably linked to a heterologous promoter functional in a plant.

44. (Previously presented) The isolated nucleic acid molecule of claim 43, wherein said nucleic acid molecule encodes a polypeptide comprising the amino acid sequence of SEQ ID NO: 39.

45. (Currently amended) An isolated nucleic acid molecule which encodes a polypeptide comprising an amino acid sequence which is at least 90% identical over its entire length to the amino acid sequence of SEQ ID NO: 39, wherein the isolated nucleic acid molecule is operably linked to a heterologous promoter functional in a plant.

## **REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. §1.111**

### **A. Status of the Claims**

The Action states that claims 1-10, 13-41 and 43-48 are pending. It is believed by Applicants however that claims 46-48 have not been added in the case. It is therefore believed that claims 1-10, 13-41 and 43-45 were pending at the time of the Action.

Claims 1-10 and 13-41 have been canceled herein without prejudice or disclaimer. Applicants reserve the right to prosecute any canceled subject matter in one or more continuing applications. Claims 11, 12, 42, 43 and 45 have been amended. Support for the amendments can be found, at least, at page 14, lines 1-27 of the specification. The amendments do not broaden the claims and therefore the claims are fully within the scope of elected subject matter. Claims 11-12 and 43-45 are now pending and are presented for reconsideration.

### **B. Rejections Under 35 U.S.C. §112, First Paragraph – Written Description**

The Action rejects claims 1 and 10 under 35 U.S.C. 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to convey to one of skill in the art that Applicants were in possession of the claimed subject matter. Applicants respectfully traverse the rejection but note that, in the interest of compact prosecution of the case, the claims have been canceled herein. The rejection is therefore now moot and removal thereof is respectfully requested.

### **C. Rejections Under 35 U.S.C. §112, First Paragraph - Enablement**

The Action rejects claims 1 and 10 under 35 U.S.C. 112, first paragraph, as not being enabled by the specification. Applicants respectfully traverse the rejection but note that, in the

interest of compact prosecution of the case, the claims have been canceled herein. The rejection is therefore now moot and removal thereof is respectfully requested.

**D. Rejection Under 35 U.S.C. §102(e)**

Claims 1, 10 and 43-48 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Lassner *et al.* (U.S. Patent No. 6,541,259, filed April 14, 2000). In particular it is stated that Lassner *et al.* discloses SEQ ID NOs:38 and 39.

Applicants first note that the current claims are directed to isolated nucleic acid molecules encoding tocopherol cyclase that are operably linked to a heterologous promoter functional in a plant. The Lassner *et al.* patent has not been alleged to teach SEQ ID NO:38 or 39 operably linked to heterologous promoters. Indeed, the Action has not alleged that any function at all has been suggested for these sequences that would motivate one of skill in the art to make such a combination. As all elements of the currently claimed invention have not been shown in the cited reference, the claims are not anticipated under 35 U.S.C. § 102(e).

Applicants further note that the Lassner *et al.* inventors and the current inventors were under a common duty of assignment at the time the invention was made. Lassner *et al.* is therefore not prior art pursuant to 35 U.S.C. §102(e)/103(c). Specifically, Monsanto Company owned Calgene LLC and Monsanto Technology LLC at the time the inventions were made. All of the inventors had a duty to assign and/or had assigned to Monsanto Company or its wholly owned subsidiaries at the time the inventions were made. The Lassner *et al.* patent therefore may not be used to reject the claims under 35 U.S.C. §102(e)/103(c). MPEP § 706.02(l)(2).

In view of the foregoing, removal of the rejection is respectfully requested.

**E. Conclusion**

In light of the foregoing, applicants submit that all claims are in condition for allowance, and an early indication to that effect is earnestly solicited. The examiner is invited to contact the undersigned (512) 536-3085 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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